



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/465,718 12/17/99 DASSEUX

J 9196-018-999

020583  
PENNIE AND EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-2711

HM22/0327

EXAMINER

BORIN, M

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

03/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/465,718**

Applicant(s)

**Dasseux et al**

Examiner

**Michael Borin**

Group Art Unit

**1631**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-55 \_\_\_\_\_ is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-55 \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1631

### **Part III DETAILED ACTION**

#### **Restriction Requirement**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, drawn to peptides of Formula I and claims 36-40 (in part related to the peptides) drawn to composition, classified in classes 514 and 530, in general.
- II. Claim 19, claims 22-27 (in part), drawn to a multimeric ApoA-I agonist of formula II and claim 36 (in part related to the ApoA-I agonist of formula II), drawn to pharmaceutical composition, classified in classes 514 and 530, in general.
- III. Claim 20, claims 22-27 (in part), drawn to a multimeric ApoA-I agonist of formula III and claim 36 (in part related to the ApoA-I agonist of formula III), drawn to pharmaceutical composition, classified in classes 514 and 530, in general.
- IV. Claim 21, claims 22-27 (in part), drawn to a multimeric ApoA-I agonists of formulas IV or V and claim 36 (in part related to the ApoA-I agonist of formula II), drawn to pharmaceutical composition, classified in classes 514 and 530, in general.

Serial Number: 09/465718

Art Unit: 1631

- V. Claims 28-35, drawn to peptide-lipid complex, and claims 41-42, drawn to pharmaceutical composition, classified in classes 514 and 530, in general.
- VI. Claims 43-52 and 54-55 (in part), drawn to method of treatment of dislipidemia, classified in class 514, in general.
- VII. Claims 43-52 and 54-55 (in part), drawn to method of treatment of septic shock, classified in class 514, in general.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I-V are patentably distinct from each other because of the materially different structures of the compounds they are claiming.

The inventions of Groups VI and VII are patentably distinct because they are drawn to treatment of disorder conditions which are patentably distinct as they are not related to each other, have different mechanisms of development and etiology, and have different enablement requirements. The groups require different literature search and a reference teaching treatment of one disorder will not teach treatment of another disorder.

Inventions I-V and VI-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

Serial Number: 09/465718

Art Unit: 1631

product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the methods of Groups VI-VII are alternative methods of using compounds of Groups I-V. Conversely, products of groups I-V are alternative products to be used in methods of Groups VI-VII.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Upon election of any single one of the Groups from above ( Groups I-VII) the following election of species is hereby required:

**Species Requirement**

The claims of Group I are individually or dependently directed to a plurality of disclosed patentably distinct species of peptides as recited in claims 5-18. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

The claims of Group IV are individually or dependently directed to a plurality of disclosed patentably distinct species of formulas IV and V. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Art Unit: 1631

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached at (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

March 22, 2001

**MICHAEL BORIN, PH.D**  
**PRIMARY EXAMINER**

